

**IN THE UNITED STATES
PATENT AND TRADEMARK OFFICE**

APPLICANTS: Mark C. Pace & Thomas W. Cook
APPLICATION NO.: 09/782,677
FILING DATE: February 12, 2001
TITLE: AUTOMATED SERVICE SCHEDULING SYSTEM BASED ON CUSTOMER
VALUE
EXAMINER: Jonathan G. Sterrett
GROUP ART UNIT: 3623
ATTY. DKT. NO.: 19538-05784

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RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Sir:

This communication is in response to the Notification of Non-Compliant Appeal Brief, mailed November 15, 2006. It is noted that when this Notification was mailed, an Examiner's Answer had already been mailed on October 27, 2006. These conflicting actions raise some confusion about whether the Patent Office has already accepted Applicants' Appeal Brief, as well as to whether the non-extendable two-month deadline to submit a Reply Brief has been triggered. Moreover, the Notification of Non-Compliant Appeal Brief relies on incorrect grounds to object to the Appeal Brief.

The Notification of Non-Compliant Appeal Brief indicates that the Appeal Brief originally filed on August 10, 2006, was defective because: (1) the “Summary of the Claimed Subject Matter” fails to “identify and map each independent claim to the specification,” and (2) the Appeal Brief lacks the “Evidence” and “Related Proceedings” appendices. Applicants respectfully assert that these are not proper grounds to object to the Appeal Brief in the present case.

The first ground is improper because it would apply a wholly different requirement than that set out in § 41.37. The rule states that the “Summary of the Claimed Subject Matter” must include a concise explanation of the subject matter defined in each of the independent claims. In the original Appeal Brief, the “Summary of the Claimed Subject Matter” did concisely explain the claimed subject matter, and that explanation included references to the specification and figures. But the Notification suggests that the “Summary of the Claimed Subject Matter” must do more than concisely explain the subject matter defined in each of the independent claims. The Notification suggests that the Appeal Brief must specifically identify each claim and map the features of the claim to the specification and drawings. There is nothing in § 41.37 or in the MPEP that requires this. The purpose is to summarize the *subject matter* defined in the claims, not the claims themselves, and there is no additional claim-by-claim mapping requirement. Here, the subject matter in the independent claims was summarized, with specific references to the specification and drawings. Applicants did not restate each independent claim and map its features to the specification because § 41.37 does not require doing so. Moreover, given that there are numerous independent claims with overlapping subject matter, such a description would hardly have constituted a “concise explanation of the subject matter,” under § 41.37.

The second ground for objecting to the Appeal Brief had already been waived by the Office. Although the MPEP interprets 37 C.F.R. § 41.37 to require “Evidence” and “Related Proceedings” appendices, even where there are no evidence or related appeals, the MPEP also says that the examiner may still accept the Appeal Brief if these appendices are missing. *See* MPEP § 1205.03. Here, the examiner mailed an Examiner’s Answer and thus did accept Applicants’ Appeal Brief.

Nevertheless, to expedite consideration of this appeal by the Board, Applicants are submitting a new version of the Appeal Brief in compliance with the Notification of Non-Compliant Appeal Brief. This new version now includes the “Evidence” and “Related Proceedings” appendices, and the “Summary of the Claimed Subject Matter” now specifically maps each independent claim to a section in the disclosure where an embodiment of the claimed feature is described.

Respectfully submitted,

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Dated: December 24, 2006

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